

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Official Action of June 29, 2005 (hereinafter "Office Action"). Applicant further appreciates the telephone interview with the Examiner of August 23, 2005. In response, Applicant has canceled Claims 1-32, 34, 36, and 38, and has amended Claims 33, 35, and 37 to overcome the present rejections, as described in detail below. No new matter has been added. Applicant therefore submits that the remaining claims are now in condition for allowance, which is respectfully requested.

Interview Summary

During the telephone interview of August 23, 2005, the present amendments to the claims were presented to the Examiner. More particularly, in Claim 33, the language "a designation of a first advertisement" and "a designation of a second advertisement" has been replaced with "an identifier of a first advertisement" and "an identifier of a second advertisement", as will be further described in detail below. Claims 35 and 37, which are system and computer program product analogs of method Claim 33, have been similarly amended. The Examiner agreed that these amendments were fully supported by the present specification, based on the support for the claim amendments further described below. The Examiner also raised questions as to how these amendments overcome the outstanding rejections under 35 USC §103 over U.S. Patent No. 5,740,549 to Reilly et al. ("Reilly") and U.S. Patent No. 6,324,519 to Eldering ("Eldering"). The reasons for patentability of the amended claims in view of the cited references will also be described in detail below.

Support for the Claim Amendments

As noted in the telephone interview, support for the claim amendments may be found in the application as filed. For example, during the interview, the undersigned quoted Page 4, paragraph 0042, of the present application:

Designations of content for respective ones of the individual subscribers who have been determined to have individualized targeted content are obtained by the content provider (block 515). The obtained designations of content may comprise the actual

content to be included, or an identifier of information to be included. The identifier may be an identifier of information maintained, for example, by the publisher. Similarly, where the content provider is an advertising distributor and the content is associated with different target advertisers, operations in obtaining the individual content may include obtaining the content from respective identified target advertisers or from associated databases maintained by the content provider including associated content for respective target advertisers. The designation of content for respective subscribers is then transmitted, for example, to the publisher (block 520). (*Emphasis added*).

As such, embodiments of the present invention provide that a designation of an advertisement (or other content) may include not only the *actual* advertisement to be included in the publication, but also an *identifier* of the actual advertisement. The actual advertisement may be maintained, for example, by a publisher, rather than by an advertiser. Accordingly, the amendments to Claims 33, 35, and 37 are well-supported by the present application, and no new matter has been added.

Claims 33, 35, and 37 Are Patentable Over the Cited References

Claims 33, 35, and 37 stand rejected under 35 USC §103(a) as being unpatentable over Reilly in view of Eldering. In order to clarify patentability of the present invention, Claim 33 has been amended to recite:

33. A method for subscriber based generation of a customized publication comprising the steps of:

generating a subscriber list including identifications of a plurality of subscribers for the publication;

providing, to an advertiser, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber;

receiving an identifier of a first advertisement based on buying preferences of the first subscriber and an identifier of a second advertisement based on buying preferences of the second subscriber from the advertiser;

associating the first advertisement with the first subscriber based on the identification of the first subscriber;

associating the second advertisement, different from the first advertisement, with the second subscriber based on the identification of the second subscriber; and then

generating a first version of the publication including the first advertisement in

a prescribed field of the publication for the first subscriber;
generating a second version of the publication including the second advertisement in a prescribed field of the publication for the second subscriber;
integrating content not designated by the advertiser into the first version of the publication and the second version of the publication;
printing the first version and the second version of the publication; and
distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber. (*Emphasis added*).

Applicant respectfully submits that the cited references, either alone or in combination, do not disclose or suggest the recitations of Claim 33 as amended. For example, Reilly describes an information and advertising distribution system including an information server and a client computer/workstation. The server maintains content, such as news items and advertisements, which is transmitted from the server and received at the client computer/workstation. *See* Reilly, Fig. 12. More specifically, as described in Reilly, a "data server stores and updates a database of information items and advertisements...[and] [w]orkstations remotely located from the data server each include...a communication interface for receiving at least a subset of the information items and advertisements in the data server's database". *See* Reilly, Abstract. As such, the client computer/workstation described in Reilly receives *actual* information items and/or advertisement content from the information server.

In contrast, Claim 33 as amended recites "receiving an identifier of a first advertisement...and an identifier of a second advertisement...from the advertiser". In other words, an identifier of an advertisement (in contrast to the advertisement itself) is received from the advertiser. As an initial matter, Applicant submits that Reilly does not appear to contain any mention of such an advertiser. Moreover, even were the server of Reilly to be construed as an advertiser, nowhere does Reilly appear to disclose or suggest receiving an identifier of an advertisement, in lieu of the advertisement content itself, from the server. Accordingly, Applicant submits that Reilly does not appear to disclose or suggest all of the recitations of Claim 33.

Nor does Eldering appear to provide such recitations. Eldering describes a system

where advertisers can bid to have their printed material included in a publication that is delivered to multiple subscribers. As described in Eldering, an "[a]dvertiser **144** maintains an ad server **146** which contains a variety of advertisements". *See* Eldering, Col. 4, lines 7-8. Eldering further describes that "the advertisement is delivered to the content/opportunity provider who delivers the ad to the consumer." *See* Eldering, Col. 1, lines 55-56. More specifically, as shown in Fig. 7 of Eldering, an advertisement **750** is transmitted from the advertiser **144** and received at the content/opportunity provider **160**. *See* Eldering, Fig. 7. In other words, Eldering discloses that the actual advertisement **750**, rather than a identifier thereof, is received from the advertiser **144**. Thus, Eldering also does not appear to disclose or suggest "receiving an identifier of a first advertisement...and an identifier of a second advertisement...from the advertiser", as recited by Claim 33 as amended.

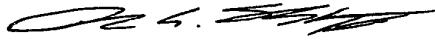
Accordingly, neither Reilly nor Eldering disclose or suggest all of the recitations of Claim 33 as amended. As such, Applicant submits that Claim 33 is patentable over the combination of Reilly and Eldering for at least the reasons described above. Claims 35 and 37 are system and computer program product analogs of Claim 33, and have been amended to include recitations corresponding to those discussed with reference to Claim 33. As such, Claims 35 and 37 are patentable for at least substantially the same reasons.

Conclusion

In view of the arguments presented above, Applicant respectfully submits that Claims 33, 35, and 37 as amended are patentable over the cited references. Accordingly, Applicant respectfully requests allowance remaining of Claims 33, 35, and 37 and passing this application to issue.

In re: Mark E. Peters
Serial No. 09/753,882
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Respectfully submitted,

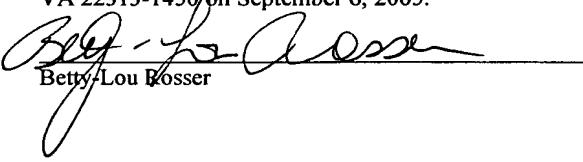


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